REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 28, 2009 (hereinafter Office Action) have been considered. Claims 1-16 and 19-32 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

1.   Claims 9 and 12 are rejected based on 35 U.S.C. §112, second paragraph, as being indefinite.

Applicants have amended Claims 9 and 12 to change the term "the presence server" to "a presence server" as noted in the Office Action. Withdrawal of the rejection is respectfully solicited.

2.   Claims 1, 2, 4, 10-14, 16 and 18-32 are rejected based on 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,095 to Yoakum et al. (hereinafter "Yoakum").

The Applicants respectfully submit that the claims as previously presented are not anticipated by Yoakum. However, in order to facilitate prosecution of the application and in a *bona fide* attempt to advance the application to allowance, the Applicants present this response with amendment to clarify particular aspects of the claimed invention. These amendments make more clear what is believed to have been originally set forth in these claims, but now states so more specifically.

For example, independent Claim 1 now sets forth "communicating the presence document having only the partial presence information for communicating a presence status to the terminal requesting the presence information." Similarly, independent Claim 19 now recites "a presence document having only partial presence information for communicating a presence status of the at least one presentity;" Claim 31 now recites "a presence document having only partial presence information for communicating a presence status of the at least one presentity;" and Claim 32 now recites "wherein the presence document includes only the partial presence information for communicating a presence status to the subscribing

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terminal." These amendments are fully supported in the Application as filed (e.g., Specification at p. 13, lines 25-28) and no new matter has been added.

The Examiner agrees in the Office Action with Applicants' contention that Yoakum never suggests a part of the presence information requested by a terminal is transmitted in response to a status change, but the Examiner asserts that, nonetheless, the claims are not so limited. Applicants appreciate the explanation by the Examiner, and in order to facilitate prosecution have amended the claims accordingly. Therefore, Applicants believe that independent Claims 1, 19, 31 and 32 (as well as Claims 2, 4, 10-14, 16, 18, and 20-30 which respectively depend therefrom) are allowable over Yoakum based on the present amendments.

The Applicants further note the Examiner's statements on page 3 of the Office Action that even if the specifically claimed features discussed above were introduced to distinguish from Yoakum, that such features will still not be patentable over U.S. Patent No. 7,359,938 to Davies et al (hereinafter "Davies"), U.S. Patent No. 7,469,384 to Thompson et al. (hereinafter "Thompson"), and U.S. Patent No. 7,221,658 to Armstrong (hereinafter "Armstrong"). Applicants again appreciate this additional explanation by the Examiner regarding the patentability of the claims in view of these additional references. However, Applicants respectfully submit that the combination of references, when viewed as a whole, fail to render the independent claims unpatentable.

The portions of the Davies and Armstrong references cited in the Office Action (col. 17, lines 24-34 of Davies and col. 16, lines 7-16 of Armstrong) read substantially the same, and are first considered. The cited portions describe "a change in the information [becoming] available" and in response "exposed presence manager 58 consults the rules 15 and determines what (if any) information to make available to the watching parties 12 who have active subscriptions." However, Armstrong describes these rules as "about who may contact the watched party, at what times, how often, how often during particular times, in what mode of communication a particular watching party may contact the watched party, etc." (Armstrong, col. 4, lines 15-18). For example, Armstrong describes a case where "the

watched party 13 is on line but has configured rules 15 such that no instant messages should be accepted after 9 PM." (Armstrong, col. 7, lines 18-20).

Thus when Armstrong describes at col. 12, lines 24-32 about "context presence" being "derived from a watched party's 13 raw presence according to rules" and "exposed presence" being "a view of a watched party's 13 context presence that is exposed to a watching party 12," these various versions of the presence based on user's preferences related to who may contact the watched party, at what times, how often, how often during particular times, in what mode of communication, etc. Armstrong does not expressly describe partial presence information that is status information for presence information that has changed. The context and exposed presence of Armstrong, for example, is formed without consideration to a change of status, because as Armstrong clearly states "[n]ot every new presence indicator results in a change to the context presence." (Armstrong, col. 12, lines 26-27).

Davies and Thompson are similarly deficient in expressly describing partial presence information that is status information for presence information that has changed. Like Armstrong, Davies states that a "presence management system processes raw presence information according to rules or other pre-specified criteria about users in order to provide context information that is simpler and easier for human operators to understand." (Davies, col. 5, lines 63-67). Thompson describes "sessions that are indicated to be private are only displayed on the graphical user interface of team members involved in the private communications session," which is accomplished, e.g., by way of a "watcher's frame 43c [that] contains the personal identifiers of each of the other members of the team who are currently also logged-in to the collaboration services suite 2, and who should therefore be receiving preference and presence information respecting the team member." (Thompson, col. 5, lines 12-16 and col. 11, lines 6-11).

The Armstrong, Davies, and Thompson references all fail to expressly describe, e.g., a presence document having only partial presence information for communicating a presence status of the at least one presentity, the partial presence information being less than the totality of the presence information available for the at least one presentity, wherein the

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partial presence information is status information for presence information that have changed. Accordingly, the combination of Yoakum with one or all of these references fail to suggest at least this aspect of the independent claims.

While the rejections in their present form rely on Yoakum to teach "partial presence" information as claimed, Yoakum merely expresses an axiom regarding presence information, namely that some of the presence information may change. What these references fail to teach or suggest, however, either or alone or in combination, is the formation and communication of a message with only the presence information that has changed. Nor do these references identify a problem analogous to the ones identified in the present Specification, e.g., "presence information that has already been transferred to a watcher application need not be unnecessarily transmitted from presence servers to client watcher applications." (Specification, p. 8, lines 16-17).

Applicants respectfully assert that the teachings of Yoakum, Armstrong, Davies, and Thompson would provide insufficient guidance for one of ordinary skill in the art having these references before him/her to make the combination or modification suggested by the Examiner. Thus Applicants respectfully assert that Claims 1, 2, 4, 10-14, 16 and 18-32 are allowable over Yoakum, even in view of these additional references cited by the Examiner.

3.   Claims 3 and 5 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum. Claims 6-8 and 15 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum in view of U.S. Publication No. 2002/0129103 by Birkler (hereinafter "Birkler").

The Applicants respectfully traverse the rejection, but submit that the rejections are moot in view of the amendments and arguments above. The proposed modifications to Yoakum and the Birkler reference were not relied upon to cure the deficiencies of Yoakum as applied to Claim 1 from which Claims 3, 5, 6-8, and 15 ultimately depend. Nor would Birkler or the proposed modifications provide such a cure. Accordingly, Claims 3, 5, 6-8, and 15 are in condition for allowance.

4.   Claim 9 is objected to as being dependent on a base claim, but would be allowable if rewritten in independent form and if the antecedent basis issues are corrected. Claim 17 is indicated as allowable over the prior art of record but rejected under 35 U.S.C. §101 for double patenting.

Applicants thank the Examiner for the indication of allowable subject matter. As to Claim 9, this claim has been amended to address the antecedent basis issues noted by the Examiner (see paragraph 1 hereinabove). However, Applicants have not rewritten Claim 9 in independent form, as Applicants believe that all of the pending claims are in condition for allowance in view of the amendments and remarks in the present response.

Regarding Claim 17, Applicants note that a terminal disclaimer was filed in the present case on or about 12/29/2008, and the terminal disclaimer was approved on 2/19/2009 as shown in the Patent Application Information Retrieval (PAIR) system. Accordingly, Applicants respectfully submit that the double patenting rejection referenced on page 10 of the Office Action is now moot, and Claim 17 is in condition for allowance.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.019C1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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